

REMARKS

Applicant appreciates the indication of allowable subject matter in the present application.

Applicant hereby cancels claims 4, 24, and 54 and adds claims 66-68. Accordingly, claims 1-3, 5-23, 25-44, 46-53, 55-61, and 63-68 are pending in the present application.

Claims 1-4, 16-20, 31-35, 51-57, and 63 stand rejected under 35 U.S.C. 103(a) for obviousness over U.S. Patent No. 6,084,512 to Elberty in view of U.S. Patent No. 6,480,699 to Lovoi. Claims 21-24, and 46-50 stand rejected under 35 U.S.C. 103(a) for obviousness over Elberty in view of U.S. Patent No. 5,940,006 to MacLellan et al.

Applicant respectfully traverses the rejections and urges allowance of the present application.

Referring to claim 1, the device comprises communication circuitry configured to backscatter electromagnetic energy received by the radio frequency identification device. Page 5 of the action identifies teachings of Elberty col. 9, line 41 - col. 10, lin 48) which allegedly disclose backscatter operations. Applicant disagrees.

Col. 9 of Elberty refers to receive operations of a tag and fails to disclose or suggest any operations with respect to backscatter or outputting of a wireless signal from a tag. The identified teachings of col. 10 refers to matching operations of an identifier as well as lighting an LED. Such teachings are devoid of any backscatter communications or outputting of a wireless signal. In addition, *Applicant has electronically searched Elberty and has failed to locate any backscatter teachings.* Limitations of claim 1 including the

backscattering are not shown nor suggested in the prior art and claim 1 is allowable for at least this reason.

Further, the explicit disclosure of Elberty teaches away from backscattering as claimed. More specifically, col. 10, lines 49-67 recite that the multiplier 520 doubles the frequency of the received signal and outputs a signals at 4.90 GHz. An amplifier 522 amplifies the signal before the signal is transmitted as the 4.90 GHz tag response signal. As discussed in col. 4, line 52+, the user selects the ID code that uniquely identifies the item to be localized and the generation of the double frequency response signal 122 discussed above which is received by the interrogator indicates the presence of the item. As set forth in col. 8, line 59 - col. 9, line 3, the double frequency response signal is compared with a double frequency ID code signal using mixer 426. The communication and comparison of the **double frequency response signal** 122 teaches away from any backscattering as positively-recited in claim 5. Such teaching away is the antithesis of the art's suggesting that the person of ordinary skill go in the claimed direction. Essentially, teaching away from the art is a *per se* demonstration of lack of obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988). Limitations of claim 1 are not shown nor suggested by the prior art and claim 1 is allowable for at least this reason.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to dependent claim 3, it is recited that *the received wireless signal comprises data and the communication circuitry outputs the control signal comprising the data and the indication circuitry indicates presence responsive to the control signal.* The Office Action identifies teachings in col. 10, lines 24-48 in support of the rejection. The reliance upon such teachings is misplaced. In particular, Elberty merely discloses that the processor 516 also turns on a green LED when there is a match. Elberty is devoid of disclosing or suggesting details of the mechanism for turning the LED on, let alone, that the signal used to control the indication comprises data received in the wireless signal. Limitations of claim 3 are not shown nor suggested by the prior art and claim 3 is allowable.

Referring to dependent claim 53, the teachings of Elberty identified in the Office Action in support of the rejection of claim 53 *fail to disclose or suggest any backscattering, let alone, the backscatter modulation of electromagnetic energy of a continuous wave signal* as specifically recited. Positively-recited limitations of claim 53 are not shown nor suggested and claim 53 is allowable for at least this reason.

Referring to claim 16, the device comprises communication circuitry configured to output another wireless signal comprising an identifier of the radio frequency identification device. The Examiner relies upon the teachings of MacLellan in support of the rejection. The rejection is in error.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or

in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed.).

Page 4 of the Action states that the motivation in support for modifying Elberty using MacLellan is "for providing the tag's information to the interrogator." Such bald, cursory motivational rationale is contrary to the teachings of Elberty. As set forth in col. 4, the user identifies a single item for identification. Elberty discloses communicating a signal from interrogator 100 to the single tag 500 as set forth in col. 4, lines 52+. The interrogator then awaits the reception of the response signal from the single tag. If the appropriate tag 500 receives the ID code signal 120 then the identified single tag responds with the response signal 122. Since only one tag 500 will respond to the ID code signal 120 there is no need to transmit tag identification information of MacLellan back to the interrogator. The interrogator will know that the appropriate tag 500 is present if the response 122 is received inasmuch as the code signal 120 only identifies a single tag 500. Accordingly, there is no motivation to modify the teachings of Elberty using the teachings of MacLellan and there is no *prima facie* case of obviousness.

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry

whether to combine references must be through and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth rationale on which it relied. Statements set forth in the present Office Action are akin to the alleged motivation discussed *In re Lee* and accordingly are insufficient to combine the reference teachings. The 103 rejection of claim 16 is improper without the proper motivation and Applicant respectfully requests allowance of claim 16 in the next action.

According to the motivational rationale presented in the Office Action, any teachings of a secondary reference may be combined with the teachings of a primary reference if an improvement is provided. Applicant submits the *Lee* case clearly illustrates such an interpretation is improper, conclusory, and not in compliance with the MPEP for establishing a proper *prima facie* case of obviousness. The mere fact that references can be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. MPEP §2143.01 *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The motivation for forming a combination of references or modification thereof must be something other than hindsight reconstruction based on using the Applicant's invention as a road map for such a combination or modification. See, for example, *Interconnect Planning Corp. vs. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990) (explaining that hindsight reconstruction is an improper basis for a rejection of a claim). Knowledge of Applicant's disclosure must be put aside in reaching a determination whether the claimed invention "as a whole" would have been obvious at the time when the invention was made. MPEP §2142, (8th edition); see also MPEP §2143, (8th edition). No motivation exists, and accordingly, the Examiner has improperly relied upon teachings of Applicant's disclosure to arrive at the 103 rejection. Claim 16 is allowable.

The claims which depend from independent claim 16 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, dependent claim 19 recites outputting the wireless signal comprising a modulated continuous wave signal. Page 4 of the Office Action recites teachings in col. 4, lines 21-25, col. 5, lines 23-49 and Fig. 5 of Elberty which allegedly disclose limitations of claim 19. The identified teachings merely refer to a tag response signal 122 however there is absolutely no teaching or suggestion that the tag response signal comprises a modulated continuous wave signal as claimed. Further, the Office Action fails to identify any teachings which disclose the modulated continuous wave signal.

Claim 19 is allowable for at least this additional reason.

Referring to independent claim 21, the radio frequency identification devices are individually configured to backscatter electromagnetic energy. The prior art is devoid of any backscatter teachings as positively recited. Elberty is directed towards outputting a double frequency signal which is devoid of any backscattering as claimed. Further, Elberty teaches away from backscattering. Positively recited limitations of claim 21 are not shown nor suggested by the prior art and claim 21 is allowable for at least this reason.

The claims which depend from independent claim 21 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to independent claim 31, the method recites outputting another wireless signal comprising backscattering electromagnetic energy. Elberty and the other prior art references of record fail to disclose or suggest the positively-recited backscattering and claim 31 recites allowable subject matter for at least this reason.

The claims which depend from independent claim 31 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to the rejection of claim 46, it is stated on pages 6-7 of the Action that it would be obvious to combine the teachings of MacLellan with the teachings of Elberty in support of the rejection. As mentioned above, Elberty provides a system wherein the response signal identifies the single communicating addressed tag 500. Accordingly, there is no motivation to combine the teachings of MacLellan regarding a tag identifier with the teachings of Elberty inasmuch as Elberty already provides the tag identification. The only motivation results from improper usage of Applicant's disclosure. The Office Action fails to present a *prima facie* claim of obviousness and claim 46 is allowable for at least this reason.

The claims which depend from independent claim 46 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, Elberty fails to disclose or suggest outputting an identifier but merely discloses outputting the double frequency response signal 122.

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Support for the amendments and the new claims is found at least at Figs. 1-5 and the associated specification teachings of the originally-filed application.

Applicant respectfully requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: 2/23/04

By:


James D. Shaurette
Reg. No. 39,833